IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

JOHN B. ADRAIN, Plaintiff, v. VIGILANT VIDEO, INC. and THE CITY OF PORT ARTHUR, TEXAS, Defendants.	**Case No. 2:10-CV-173-TJW-CE** **ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIM**

Defendant Vigilant Video, Inc. ("Vigilant") Answers the Complaint herein as follows:

ANSWER

1.

Vigilant is without sufficient knowledge or information to admit or deny the allegations of Paragraph 1 of the Complaint, and so denies such allegations.

2.

Vigilant admits the allegations of Paragraph 2 of the Complaint.

3.

Vigilant is without sufficient knowledge or information to admit or deny the allegations of Paragraph 3 of the Complaint, and so denies such allegations.

4.

Vigilant admits the [jurisdictional] allegations of Paragraph 4 of the Complaint.

5.

Vigilant admits the [subject matter jurisdiction] allegations of Paragraph 5 of the Complaint.

6.

Vigilant admits that it has operated, conducted, engaged in, and/or carried on business in the State of Texas.

7.

Vigilant admits the [venue] allegations of Paragraph 7 of the Complaint.

8.

Vigilant admits the first allegation of Paragraph 8 of the Complaint as to the issue of said ‘669 patent but is without sufficient knowledge or information to admit or deny the second allegation of Paragraph 8 of the Complaint and so denies such allegation.

9.

Because it is merely a statement of Patent Law, Vigilant admits the allegations of Paragraph 9 of the Complaint.

10.

Vigilant denies the allegations of Paragraph 10 of the Complaint to the extent that it alleges that Vigilant has committed any acts of infringement on the Plaintiff’s ‘699 patent whether literal (direct and indirect) or through the doctrine of equivalents.

11.

Vigilant denies the allegations of Paragraph 11 of the Complaint.

12.

Vigilant denies the allegations of Paragraph 12 of the Complaint.

13.

Vigilant denies the allegations of Paragraph 13 of the Complaint.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

(Noninfringement)

14.

Vigilant alleges that it has not infringed and or is not infringing any valid claim of the ‘669 Patent, either literally, or under the doctrine of equivalents, or by inducing or contributing to infringement by others.

SECOND AFFIRMATIVE DEFENSE

(Patent Invalidity)

15.

Vigilant is informed and believes and therefore alleges that the claims of the ‘669 Patent are invalid and unenforceable pursuant to 35 USC §§ 102, 103, and/or 112.

16.

The ‘669 patent is invalid under 35 U.S.C. §102 and 103 as there is prior art that predates its filing date of July 9, 1996 and that anticipates, or in combination with other prior art, teaches all elements of the claims in the ‘669 patent.

17.

The ‘669 patent is invalid under 35 U.S.C. §101, and §112 because it is indefinite, fails to distinctly claim what the inventor regards as his invention, is not enabled, fails to disclose its best mode, lacks an adequate written description, or lacks utility.

THIRD AFFIRMATIVE DEFENSE

(Unclean Hands)

18.

Vigilant is informed and believes and thereon alleges that Plaintiff’s claims as alleged against Vigilant are barred by the doctrine of unclean hands.

FOURTH AFFIRMATIVE DEFENSE

(Limitation by Prior Art)

19.

Vigilant is informed and believes and thereon alleges that the prior art known before the alleged invention in combination with prosecutorial estoppel (as defined through the file wrapper) so limits and restricts the scope of the claims of the ‘669 Patent that Vigilant cannot be considered to have infringed the ‘669 Patent.

FIFTH AFFIRMATIVE DEFENSE

(Reservation of Other Affirmative Defenses)

20.

Vigilant is presently unaware of all of the facts and evidence surrounding the subject allegations and incidents in the Complaint herein, and therefore is unable to ascertain at this time whether Vigilant may have any additional Affirmative Defenses. Therefore, Vigilant expressly reserves the right to amend this Answer to assert such other Affirmative Defenses as may arise such as (but not limited to) Marking Estoppel under 35 USC §287, Equitable Estoppel and Laches under 35 USC §282, Inequitable Conduct, Patent Misuse, Fraud upon the Patent Office, Intervening Rights under 35 USC §252 and Prosecutorial Estoppel.

COUNTERCLAIM

(Declaratory Judgment of Non-Infringement

and Invalidity for US Patent No. 5,831,669)

21.

Paragraphs 1- 20 are incorporated by reference as if stated fully herein.

22.

Vigilant alleges on information and belief that said ‘669 patent is invalid, unenforceable, and void, for one or more of the reasons that:

(a) Vigilant has not infringed any claim of said patent;

(b) By reason of the proceedings in the Patent Office during the prosecution of the application which resulted in said patent as shown by the file wrapper thereof, Plaintiff is estopped to claim for said patent a construction that would cause said patent to cover or include any apparatus or device or product or method manufactured, used, or sold by Vigilant;

(c) The patent in suit is unenforceable under 35, USC §185 by reason of a foreign counterpart application having been filed in violation of 35 USC §184, i.e., without there having first been obtained a license for such foreign filing;

(d) The patentee did not invent the subject matter patented, nor did he make any invention or discovery, either novel, original, or otherwise, within the meaning of United States Code, Title 35;

(e) The alleged invention was made by another in this country before the patentee's alleged invention, and such other person had not abandoned, suppressed, or concealed it;

(f) New matter was introduced into the disclosure and claims during the prosecution of the application for said patent;

(g) The patent does not particularly point out and distinctly claim the part, improvement, method, steps, or combination which the patentee claims as his invention, as required by Title 35, United States Code;

(h) The specification does not contain a written description of the invention and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it pertains, or with which it is most nearly connected, to make, construct, compound, and/or use the same, and the description does not adequately explain the principle or the best mode in which the patentee contemplated applying that principle so as to distinguish it from other inventions, as required by Title 35, United States Code;

(i) The claims, and each of them, of the patent are excessively vague and indefinite and do not distinctly point out and define the invention;

(j) The claims, and each of them, are not directed to patentable combinations, but are directed to mere aggregations of parts or steps, means, or elements which were matters of common knowledge in the art to which said patent relates before the alleged invention and more than one year prior to the date of the application for the patent;

(k) The structures and/or combinations and/or methods disclosed in the patent are inoperative and incapable of accomplishing the intended result, and are not useful within the meaning and requirements of Title 35, United States Code;

(l) In light of the prior art at the time the alleged invention was made, the subject matter as claimed in the patent would have been obvious to a person skilled in the art to which the alleged invention relates and does not constitute a patentable invention;

(m) The alleged invention or discovery was disclosed in a United States patent to another, the application for which was filed before the alleged invention by the patentee of the patent in suit;

(n) Before the alleged invention or discovery by the patentee, the alleged invention was known or used by others than the alleged inventor and was on sale in this country and was patented or described in printed publications in this or in foreign countries;

(o) If there be any invention in the subject matter of the patent in suit, which is denied, the patent nevertheless was not obtained in a manner consistent with the provisions of Title 35, United States Code; and/or

(p) The claims of the patent in suit are non-functional, indefinite, and are broader than the alleged invention as set forth in the specification of the patent in suit

23.

Vigilant is entitled to a declaration of this Court that Vigilant is not infringing on the ‘669 patent, and that the ‘669 patent is invalid.

Vigilant seeks the remedies set forth in its Prayer for Relief.

WHEREFORE, having fully Answered and Defended against Plaintiff's Complaint herein, Vigilant prays for Judgment as follows:

1. That the Complaint against it be dismissed, and that the Plaintiff take nothing thereby as against Vigilant;

2. For a declaration of this Court that Vigilant is not infringing on the '669 patent, and that the '669 patent is invalid;

3. For an award to Vigilant of its costs, disbursements, and expenses incurred herein;

4. That the Court declare this an exceptional case under 35 USC §285 and award to Vigilant its attorney's fees incurred herein; and

5. For such other relief that is found to be just and equitable.

JURY DEMAND

Pursuant to FRCivP 38(b) and LR CV-38, Defendant demands a jury trial on all issues triable to a jury.

DATED: July 20, 2010

THOMPSON ✦ BOGRÁN, P.C.

/s/ Roy B. Thompson
Roy B. Thompson, OSB 82501 (*pro hac vice*)
15938 SW Quarry Rd., Suite B-6
Lake Oswego, OR 97035
Telephone: 503-245-6600
Cellphone: 503-381-9945
Facsimile: 503-244-8399
E-mail: roythompson@comcast.net

/s/ Mark S. Hubert
Mark S. Hubert, OSB 98256 (*pro hac vice*)
e-mail: markhubert@pacifier.com
MARK S. HUBERT, PC
2300 SW First, Suite 200
Portland, OR 97201
Telephone: 503-234-7711
Facsimile: 503-224-0092
Attorneys for Defendant Vigilant Video, Inc.

CERTIFICATE OF SERVICE

I hereby certify that I served the foregoing **DEFENDANT VIGILANT VIDEO, INC.'S ANSWER, AFFIRMATIVE DEFENSES AND** on the following:

C. Dale Quisenberry dquisenberry@pqelaw.com
John T. Polasek tpolasek@pqelaw.com
Jeffrey Scott David jdavid@pqelaw.com
POLASEK QUISENBERRY & ERRINGTON, LLP
6750 West Loop South, Suite 920
Bellaire TX 77401
Telephone: 832-778-6000
Facsimile: 832-778-6010
Of Attorneys for Plaintiff

Elizabeth L. DeRieux ederieux@capshawlaw.com
CAPSHAW DERIEUX LLP
Energy Centre
1127 Judson Rd., Suite 220
PO Box 3999 (75606-3999)
Longview TX 75601-5157
Telephone: 903-236-9800
Facsimile: 903-236-8787
Of Attorneys for Plaintiff

Frank D. Calvert fcalvert@calvert-eaves.com
CALVERT EAVES CLARKE & STELLY, LLP
The Beaumont Tower
2615 Calder Avenue, Suite 1070
Beaumont, TX 77702
Telephone: 409-832-8885
Attorney for Defendant City of Port Arthur

electronically via the Court's CM/ECF system.

DATED: July 20, 2010

THOMPSON ✦ BOGRÁN, P.C.
/s/ Roy B. Thompson
Roy B. Thompson, OSB 82501 (*pro hac vice*)
15938 Quarry Road, Suite B-6
Lake Oswego, OR 97035
Telephone: 503-245-6600
Cellphone: 503-381-9945
Facsimile: 503-244-8399
E-mail: roythompson@comcast.net
Attorney for Defendant Vigilant Video Inc.